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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,540	08/08/2001	Kei Hagiwara	R2184.0116/P116	2104

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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,540

Applicant(s)

HAGIWARA ET AL.

Examiner

Jorge L Ortiz-Criado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/08/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3.6.9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species e, Figs. 17-24 and claims 24-31 in Paper No. 11, filed on March 03, 2004 is acknowledged.

The traversal is on the ground(s) that “*the sets of claims would not provide a serious burden upon the Examiner*”.

The Examiner cannot concur because the application contains claims directed to the patentably distinct species of the claimed invention as specified in the prior art and according with MPEP § 803 reproduced below:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate pat-ents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i))

and according to section of MPEP § 803 (A), reproduced below:

The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01)

As provided in MPEP § 806.04 (Independent Inventions) reproduced below:

“If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions”;

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specifically MPEP § 806.04 (C), reproduced bellow:

“(C) Where species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power”.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on March 03, 2004.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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4. The abstract of the disclosure is objected to because legal phraseology often used in patent claims, such as "means", should be avoided. Correction is required. See MPEP § 608.01(b).

Claim Objections

5. Claim 25 is objected to because of the following informalities: Claim 25 recites two values (1) "optimum recording-state targeted value" and a (2) "recording-state targeted value". And further the claim recites the feature of "comparing said recording-state targeted value with said value". It is unclear what "value" from the two values as outlined above is taken in the comparison. The recited feature "said value" should be "optimum recording-state targeted value". Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 24-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogawa U.S. patent No. 6,704,269.

Regarding claim 24, Ogawa discloses an information recording device writing information in a circumferential direction of a disk-type recording medium with a substantially constant linear density (See col. 2, line 25 to col. 3, line 52; Figs. 1-21), the device comprising:

test-writing means for performing a test-writing in a predetermined area on said disk-type recording medium at a predetermined basic linear velocity so as to determine an optimum recording power at said basic linear velocity according to a result of said test-writing (See col. 2, line 62 to col. 3, line 52); and

recording-power setting means for setting a recording power according to a result of a predetermined calculation performed to said optimum recording power, when a recording is performed on said disk-type recording medium at a linear velocity different from said predetermined basic linear velocity (See col. 2, line 62 to col. 3, line 52).

Regarding claim 25, Ogawa discloses wherein said test-writing means includes optimum recording-state storing means for storing a value in accordance with a reproduction signal reproduced from said disk-type recording medium as an optimum recording-state targeted value, when a recording is performed on said disk-type recording medium with said optimum recording power (See col. 2, line 62 to col. 3, line 52; Figs. 1, 21); and

said recording-power setting means includes: recording-state targeted value setting means for setting a recording-state targeted value according to a result of a predetermined calculation

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performed to said optimum recording-state targeted value, when the recording is performed on said disk-type recording medium at the linear velocity different from the predetermined basic linear velocity (See col. 2, line 62 to col. 3, line 52; Figs. 1, 21); and

power correcting means for correcting said recording power by comparing said recording-state targeted value with said value during a recording of information to said disk-type recording medium (See col. 2, line 62 to col. 3, line 52; col. 8, line 41 to col. 10, line 46; Figs. 1, 21)

Regarding claim 26, Ogawa discloses including operational expression/coefficient setting means for setting at least one of an operational expression and a coefficient performing said predetermined calculation, in accordance with a type of said disk-type recording medium (See col. 2, line 62 to col. 3, line 52; col. 8, line 41 to col. 10, line 46; Figs. 1, 21)

Regarding claim 27, Ogawa discloses including medium-type judging means for judging the type of said disk-type recording medium according to an identification code embedded in said disk-type recording medium (See col. 2, line 62 to col. 3, line 52; col. 5, lines Figs. 1, 21)

Regarding claim 28, Ogawa discloses including record-pulse-width changing means for changing a record pulse width according to said linear velocity (See col. 2, line 62 to col. 3, line 52; col. 8, line 41 to col. 10, line 46; Figs. 1, 21)

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Regarding claim 29, Ogawa discloses including record-pulse-width changing means for changing a record pulse width according to said linear velocity (See col. 2, line 62 to col. 3, line 52; col. 8, line 41 to col. 10, line 46; Figs. 1, 21)

Regarding claim 30, Ogawa discloses including record-pulse-width changing means for changing a record pulse width according to at least one of said linear velocity and the type of said disk-type recording medium. (See col. 2, line 62 to col. 3, line 52; col. 8, line 41 to col. 10, line 46; Figs. 1, 21)

Regarding claim 31, Ogawa discloses including record-pulse-width changing means for changing a record pulse width according to at least one of said linear velocity and the type of said disk-type recording medium (See col. 2, line 62 to col. 3, line 52; col. 8, line 41 to col. 10, line 46; Figs. 1, 21)

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent No. 6,052,347 to Miyata, which discloses an information recording device writing information in a circumferential direction of a disk-type recording medium with a substantially constant linear density comprising test-writing means for performing a test-writing in a predetermined area on said disk-type recording medium at a predetermined basic linear velocity so as to determine an optimum recording power at said basic linear velocity according to a result of said test-writing; and recording-power setting means for setting a recording power according to a result of a predetermined

calculation performed to said optimum recording power, when a recording is performed on said disk-type recording medium at a linear velocity different from said predetermined basic linear velocity.

b. U.S. Patent No. 6,222,815 to Nagano, which discloses an information recording device writing information in a circumferential direction of a disk-type recording medium with a substantially constant linear density comprising test-writing means for performing a test-writing in a predetermined area on said disk-type recording medium at a predetermined basic linear velocity so as to determine an optimum recording power at said basic linear velocity according to a result of said test-writing including record-pulse-width changing means for changing a record pulse width according to the type of said disk-type recording medium.

c. U.S. Patent No. 5,872,763 to Osakabe, which discloses an information recording device writing information in a circumferential direction of a disk-type recording medium with a substantially constant linear density comprising test-writing means for performing a test-writing in a predetermined area on said disk-type recording medium at a predetermined basic linear velocity so as to determine an optimum recording power at said basic linear velocity according to a result of said test-writing

d. U.S. Patent No. 5,502,702 to Nakajo, which discloses an information recording device writing information in a circumferential direction of a disk-type recording medium with a substantially constant linear density comprising test-writing means for performing a test-writing in a predetermined area on said disk-type recording medium at a predetermined basic linear velocity so as to determine an optimum recording power at

said basic linear velocity according to a result of said test-writing including record-pulse-width changing means for changing a record pulse width according to at least one of said linear velocity and the type of said disk-type recording medium and including medium-type judging means for judging the type of said disk-type recording medium according to an identification code embedded in said disk-type recording medium

e. U.S. Patent No. 5,974,021 to Toda et al., which discloses an information recording device writing information in a circumferential direction of a disk-type recording medium with a substantially constant linear density comprising test-writing means for performing a test-writing in a predetermined area on said disk-type recording medium at a predetermined basic linear velocity so as to determine an optimum recording power at said basic linear velocity according to a result of said test-writing.

f. U.S. Patent No. 5,592,463 to Muramatsu et al., which an information recording device writing information in a circumferential direction of a disk-type recording medium with a substantially constant linear density comprising test-writing means for performing a test-writing in a predetermined area on said disk-type recording medium at a predetermined basic linear velocity so as to determine an optimum recording power at said basic linear velocity according to a result of said test-writing and recording-power setting means for setting a recording power according to a result of a predetermined calculation performed to said optimum recording power, when a recording is performed on said disk-type recording medium at a linear velocity different from said predetermined basic linear velocity.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L Ortiz-Criado whose telephone number is (703) 305-8323. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm),Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris H To can be reached on (703) 305-4827. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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W. R. YOUNG
PRIMARY EXAMINER